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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,519	08/10/2000	Jacques P. Dumas	5051	6414

7590 08/13/2003

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/636,519

Applicant(s)

DUMAS ET AL.

Examiner

Venkataraman Balasubramanian

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7-11,13-17 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-11,13-17 and 20-25 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

Applicants' response filed on 5/21/2003, is made of record.

Claims 1-5, 7-11, 13-17 and 19-25 are pending.

In view of applicants response the following apply.

As for Election/Restrictions, the election as noted in the previous office action was deemed as without traverse. Hence there is no issue of rejoining the non-elected, in this case non-examined, subject matter. Applicants are reminded that it is to their interest to exclude the non-elected subject matter from instant pending claims.

The following rejections made in the previous office action also remain.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5, 7-11, 13-17, and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bold et al. US 6,258,812 (or equivalent WO 98/35958) for reasons of record.

This rejection is similar to that made in the previous office action. Applicants' argument to overcome this rejection is not persuasive.

First of all applicants should note that Bold et al. was applied earlier ad 102(e) rejection and 103 rejection. Thus the reference anticipates the originally presented claims and would render them as obvious variant.

As for applicants traversal that instant invention is not an obvious variant, based on the applicants own acknowledgement that compounds taught by Bold et al. include

Art Unit: 1624

compounds of instant invention and that generically claimed compounds of instant invention overlap with those generically taught by Bold et al., clearly negates that argument. Given the fact that Bold et al. exemplifies several compounds and teaches generically compounds that would be useful for the utility recited therein, one trained in the art would expect that the genus as whole would have the said utility and would be motivated to make the compounds of the genus given the guidance to make select compounds exemplified therein.

Contrary to the applicants urging that one need to choose several groups to arrive at the instant compounds, it is held that the compounds taught by Bold et al. would provide adequate guidance to arrive at the compounds generically claimed in Bold and hence the compounds of the instant claims would be obvious variant of the teachings of Bold et al.

As for applicants' urging that all compounds taught by Bold et al. does not have same IC<sub>50</sub>, it is deemed as not a proper comparison to show unexpected/ superior results. Applicants should choose the closest prior art compound and compare it with instant compound. Furthermore, applicants' have not shown that all the compounds generically embraced in the instant invention would have the same IC<sub>50</sub>

As for method of use claims 20-25, the rejection is proper as the teaching of Bold et al. relates proliferative diseases. Several diseases recited in these claims appear to be proliferative in nature. For example, diabetic retinopathy is a proliferative disease. Applicants can provide evidence the said diseases are not proliferative and therefore not read on the utility taught by the reference.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the instant case, the compounds of instant claims as noted above are anticipated by Bold et al. and the genus of the instant claims also overlaps with the generically taught genus of Bold et al. Bold et al. clearly teaches equivalency of the compounds exemplified with those generically claimed for the utility taught therein. . There is no hindsight analysis is required to make any of the compound of the genus taught by Bold et al.

Hence this rejection is proper and is maintained.

Claims 1-5, 7-11, 13-17, and 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. EP 0 722 936 for reasons of record.

Applicants' traversal is not persuasive. Again applicants are arguing that one trained I in the art would not be able to variable groups taught by Watanabe et al.

As noted in the previous office action, Watanabe et al. clearly generically teaches several compounds which are also claimed in the instant invention and Watanabe also provides guidance for making 72 compounds. There is clear teaching of equivalency to

the generically claimed compounds with those exemplified in the 72 examples for the utility taught therein.

There is enough guidance for one to choose compounds from the genus and there is expectation that such compounds would also share the same utility. Thus the requirement of 103 rejection, motivation and expectation of success is met with.

Again, the method of use claims 20-25 are included in the rejection since the compounds of Watanabe et al. are cGMP phosphodiesterase inhibitors. Applicants can provide evidence that such a mode of action has no relevance to said diseases of the instant claims.

#### ***Allowable Subject Matter***

Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Said claim would be allowed since specific species embraced in this claim are not taught or suggested by the art of record or from a search in the relevant art area.

#### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 1624

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

 V. Balasubramanian (Bala)

8/7/2003

  
MUKUND J. SHAH

SUPERVISORY PATENT EXAMINER

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